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PCT LEGAL ADMINISTRATION

In re Application of	:	
Schneider et al.	:	
Application No.: 10/579,786	:	DECISION
PCT No.: PCT/US03/04507	:	
Int. Filing Date: 19 February 2003	:	ON
Earliest Priority Date: 22 February 2002	:	
Attorney Docket No.: 25815-100-03	:	PETITION
For: Magnetic Label Stock Material	:	

This is in response to the petition under 37 CFR 1.137(b) filed on 12 January 2011, which also includes a renewed submission under 37 CFR 1.497(d).

DISCUSSION

Petition Under 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed on 12 January 2011 in the above-captioned application is hereby **GRANTED**, as follows:

Petitioner states that "the entire delay in filing the required reply from the due date of the required reply until the filing of a grantable petition under 37 C.F.R. 1.137(b) was unintentional."

A review of the application file reveals that applicant has paid the petition fee. The required reply was a "proper response" to the Decision mailed on 28 September 2006; the instant submission satisfies that requirement. No terminal disclaimer is required.

The above-identified application has been abandoned for an extended period of time. The USPTO is relying on petitioner's duty of candor and good faith and accepting the statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 CFR 10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 CFR 1.137(b) to the USPTO).

Submission Under 37 CFR 1.497(d)

In a Decision mailed on 28 September 2006, the submission under 37 CFR 1.497(d) filed on 23 August 2006 was dismissed, without prejudice, because

Regarding requirement (1), applicants have provided a purported "statement from: Jon B. Schneider," but this statement has not been signed by Mr. Schneider. Accordingly, requirement (1) has not been satisfied.

Regarding requirement (3), the "Written assent of assignee" portion of the correspondence filed on 23 August 2006 states that "Magnum Magnetics Corporation agrees to the deletion of Jon B. Schneider as a co-inventor of this

application,” and is signed by C. Allen Love in the capacity of “President” of Magnum Magnetics Corporation...The instant submission does not satisfy 37 CFR 3.73(b)(1) because it is not accompanied by statement affirmatively identifying the assignee and supported by documentary evidence of a chain of title (and a request to record it) or by a statement specifying the reel and frame number where such documentation may be found in the records of the USPTO. Therefore, requirement (3) has not been satisfied. Based on the totality of the evidence of record, it would not be appropriate to conclude that the requirements of 37 CFR 1.497(d) have been satisfied.

In response, with respect to requirement (1), counsel has filed an appropriate statement by Mr. Schneider.

Regarding requirement (3), applicant filed a “Written assent of assignee” on 23 August 2006, implying that Magnum Magnetics Corporation is an assignee of the instant application. 37 CFR 1.497(d)(3) requires “If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).” This is consistent with the policy described at MPEP 324 (“When an assignee first seeks to take action in a matter before the Office with respect to a patent application, patent, or reexamination proceeding, the assignee must establish its ownership of the property to the satisfaction of the Director.”). Here, the action to be taken is the assignee’s consent to the change in inventorship. MPEP 324 expressly lists the situation where an assignee “consents to the correction of inventorship” as among the situations requiring submission of a statement under 37 CFR 3.73(b). Therefore, since applicant previously indicated that this application was assigned, an acceptable statement under 37 CFR 3.73(b) is required. Since no such statement accompanied the renewed submission under 37 CFR 1.497(d), it would not be appropriate to grant the requested relief on the basis of the present record.

DECISION

The petition under 37 CFR 1.137(b) is **GRANTED**.

The request under 37 CFR 1.497(d) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this matter is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Failure to timely reply will result in **ABANDONMENT** of this application. Any reconsideration request should include a cover letter entitled “Renewed Submission Under 37 CFR 1.497(d).”

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description “Petition for review and processing by the PCT Legal Office” or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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